

REMARKS

Claims 1-39 have been canceled and claims 40-72 have been added in the present amendment. In summary of the outstanding Office Action the drawings have been objected to under 37 CFR 1.83(a), claims 1, 3, 7, 9-20 and 38 have been withdrawn from consideration, claims 2 and 39 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,527,442 (Schulhof), and claims 4-6, 8, 21-37 and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof in view of one or more of the following: U.S. Patent No. 5,483,535 (McMillen), Examiner's purported official notice, U.S. Patent No. 6,061,440 (Delaney), and U.S. Patent No. 6,229,453 (Gardner).

Reconsideration of the outstanding objections to the drawings and rejections to the claims is respectfully requested in view of the present amendments and following remarks.

Objections to the drawings under 37 CFR 1.83(a)

The drawings have been objected to under 37 CFR 1.83(a) as allegedly not showing every feature of the invention specified in the claims. The claims containing the particular features in question have been canceled without prejudice and such features are not included in the newly added claims 40-72. Therefore, withdrawal of the present objection the drawings is respectfully requested.

Rejections under 35 USC § 102(b)

Claims 2 and 39 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,527,442 (Schulhof).

Claims 1-39 have been canceled without prejudice.

With respect to elements of newly added claim 40 that may be may arguably related to those of rejected claim 2, the Office Action states "communicating music playback from each customer household and billing customers households for the recorded music selections that are made available for playback" in rejected claim 2 is taught by Schulhof. However, newly added claim 40 makes it clear that the charging for the music selection happens upon it being recorded at the consumer site by stating that the charging of the consumer is "triggered upon the consumer recording the music selection on a storage medium located at a consumer

site.” Support for this material is located throughout the specification and in particular on page 27, lines 5-10, page 29, lines 5-10, page 10 lines 10-12, and other locations within the specification. This is opposed to what is described in Schulhof which teaches or suggests that the consumer is charged at the time of ordering, as opposed to “billing customers households for the recorded music selections...,” as stated in rejected claim 2 or “upon the consumer recording the music selection on a storage medium located at a consumer site,” according to newly added claim 40.

Furthermore, it is stated in Schulhof in column 7, lines 61-63 that “when the subscriber has completed placing the order, a payment icon is displayed that requires the subscriber to authorize billing to his account.” This is opposed to charging the consumer “upon the consumer recording the music selection on a storage medium located at a consumer site,” as appears in newly added claim 40. Also, in Schulhof the “program includes a header that ...identifies the use allocation of the material,” and “actual use may be assigned as a function of the amount paid by the subscriber.” Therefore, the header contains the previous payment information for the music program to be transmitted to the user, which means the user has already been charged for the program before it is recorded at the consumer site. This is also opposed to charging the consumer “upon a recording by the consumer of the music selection on a storage medium located at a consumer site,” as appears in newly added claim 40. Thus, for the reasons above and others, Applicants submit that all the limitations of rejected claim 40 are not taught or suggested by Schulhof.

Regarding new claims 41-72, with respect to “charging triggered upon a recording by the consumer of the music selection,” all the limitations of claims 40-72 are not taught or suggested by Schulhof or any other references cited by the Office Action for the same reasons presented above. Therefore, Applicants submit that claims 40-72 of the application are in condition for allowance.

Rejections under 35 USC § 103(a)

Claims 4-6, 8, 21-37 and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof in view of one or more of the following: U.S. Patent No. 5,483,535 (McMillen), Examiner’s purported Official Notice, U.S. Patent No. 6,061,440 (Delaney), and U.S. Patent No. 6,229,453 (Gardner).

Claims 4-6, 8, 21-37 and 38 have been canceled without prejudice and also Applicants respectfully submit that the factual assertions made by Examiner are not properly officially noticed and not based upon common knowledge, and thus hereby traverse the purported official notice. According to MPEP 2144.04 section A and *In re Alhert*, 424 F.2d, "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted are not capable of instant and unquestionable demonstration as being well known." Applicants submit that placing an icon within a catalog, placing a highlight within a catalog, creating a customer's profile, using a cell phone for ordering, using a Personal Data Assistant wireless device to order, and ordering via a wireless application protocol are not facts "capable of instant and unquestionable demonstration as being well known." The noticed facts are not considered to be common knowledge or well known in the art because they are not of notorious character and do not serve to only to "fill in the gaps" in an insubstantial manner as required by *Alhert*. In fact, each of the facts of which official notice was taken are important elements of the claims in which they appear in that they complete the music selection and ordering process. Therefore, applicants respectfully request examiner produce authority for the purported official notice.

Furthermore, applicants respectfully submit that all the limitations of claims 4-6, 8, 21-37 and 38 and newly added claims 40-72 are not taught or suggested by U.S. Patent No. 5,483,535 (McMillen), Examiner's purported official notice, U.S. Patent No. 6,061,440 (Delaney), and U.S. Patent No. 6,229,453 (Gardner) or any combination thereof.

CONCLUSION

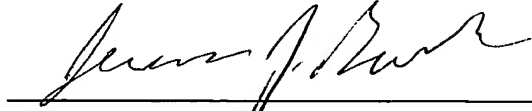
Applicants believe that the present reply is responsive to each point raised by the Examiner in the Office Action and Applicants submit that claims 40-72 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the Examiner's earliest convenience is earnestly solicited. However, should the Examiner find the claims as presented herein to not be allowable for any reason, Applicants' undersigned representative earnestly requests a telephone conference at (206) 332-1392 with both the Examiner and the Examiner's Supervisor to discuss the basis for the Examiner's continued rejection in light of the Applicant's arguments presented herein. Likewise, should the Examiner have any questions, comments, or suggestions that would expedite the

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prosecution of the present case to allowance, Applicants' undersigned representative would very much appreciate a telephone conference to discuss these issues.

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